

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte PAUL CHARLES TURGEON

Appeal No. 2005-2484
Application No. 09/394,143

ON BRIEF

Before THOMAS, BARRETT, and DIXON, **Administrative Patent Judges.**
DIXON, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-25,
which are all of the claims pending in this application. Claims 26-28 have been
canceled.

We REVERSE.

BACKGROUND

Appellant's invention relates to system and method for providing secure services over public and private networks using a removable portable computer-readable storage. A copy of representative claim 1 under appeal is set forth.

1. A system for providing financial services over a public network accessible by a plurality of customers via respective network access devices with modems and over a private network accessible by a plurality of financial institutions via computers with modems, said financial institutions maintaining respective financial accounts for said plurality of customers, at least some of said financial accounts being maintained at different ones of said financial institutions, said system comprising:

for each customer, a network access device including a programmable controller for executing code and a memory for storing a browser software to interface with said public network, said each customer using said network access device and a computer-readable portable storage medium to access said each customer's financial account via said public network, said computer-readable portable storage medium having encrypted and unencrypted information recorded thereon pertaining to said each customer's financial account; and

a decryption processor, connected to said network access device via said public network, for decrypting said encrypted information retrieved from said storage medium such that the financial institution maintaining said each customer's financial account, connected to said decryption processor via said private network, determines an access to said each customer's financial account on the basis of the decrypted information.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Campbell	4,259,720	Mar. 31, 1981
Bocinsky, Jr.	5,371,797	Dec. 6, 1994
Newton et al. (Newton)	5,771,291	Jun. 23, 1998
Solokl et al. (Solokl)	6,173,269	Jan. 9, 2001
		(Filed Apr. 7, 1999)

Claims 1-4, 9-12, 17-23, and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Newton in view of Solokl; Claims 5-8 stand rejected under U.S.C. 103(a) as being unpatentable over Newton and Solokl as applied to claim 4 above, and further in view of Bocinsky Jr.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the answer (mailed Mar. 12, 2004) for the examiner's reasoning in support of the rejections, and to the brief (filed Dec. 22, 2003) and reply brief (filed May 6, 2004) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Only those arguments actually made by appellant have been considered in this decision. Arguments that appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed

invention from the isolated teachings of the prior art. See, e.g., **Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" In *re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" In *re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." *Dembiczak*, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." In *re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited in independent claim 1. We find that independent claim 1 sets

forth various limitations that the examiner has not directly addressed in the rejection or the responsive arguments. Specifically, we do not find that the examiner has shown that the prior art references teach or fairly suggest "at least some of said financial accounts being maintained at different ones of said financial institutions" as recited in the preamble, "said computer-readable portable storage medium having encrypted and unencrypted information recorded thereon pertaining to said each customer's financial account," and that the decryption processor is "connected to said network access device via said public network, for decrypting said encrypted information retrieved from said storage medium such that the financial institution maintaining said each customer's financial account, connected to said decryption processor via said private network, determines an access to said each customer's financial account on the basis of the decrypted information." (Emphasis added.)

We note that the examiner maintains that the limitation "at least some of said financial accounts being maintained at different ones of said financial institutions" has not been given patentable weight because it appears in the preamble. The examiner maintains that this limitation can stand alone. (Answer at page 3.) We disagree with the examiner's interpretation of the instant claim language. Additionally, in the examiner's statement of the rejection the examiner states that Solokl has a processor connected to "a financial institution over a private network and determining access to a user financial account using the private network." While we agree with the examiner's statement

regarding Solokl, we find that the examiner does not address the limitation concerning the plural different financial institutions as recited in the claims. The examiner later tries to bootstrap the rejection in the responsive arguments section. The examiner maintains that the body of the claim does not refer back to those accounts that are maintained at different ones of said financial institutions. (Answer at page 9.) The examiner further maintains that the limitations are taught by Solokl and cites to a number of portions of Solokl to support this position. (Answer at pages 9-10.) Specifically, the examiner relies upon an alternative embodiment at column 6 of Solokl that uses a VISA or MASTERCARD credit card to allow/authorize the teenagers to make purchases at select merchants, but this is a different system than the Internet Passport Account discussed earlier in Solokl and referenced by the examiner which may use an Automated Clearing House (ACH). Then the examiner concludes that the "system of Solokl operates across a plurality of institutions, partner banks and 'financial institution[s]' or credit card company [sic, companies] (e.g. VISA or MASTERCARD)." We disagree with the examiner and find no such teachings of the plural customers and different financial accounts at different ones of the financial institutions as recited in independent claim 1.

Second, we do not find that either Solokl or Newton teach or fairly suggest the use of computer-readable portable storage medium having encrypted and unencrypted information recorded thereon pertaining to said each customer's financial account." The identification and authentication information stored on the CD ROM are related to

computer access to a host computer where the host computer determines the decryption and access (Newton at column 2, lines 1-2 and column 4, lines 25-27), but no suggestion of use with customer's financial accounts at financial institutions.

Third, we find no teaching or suggestion that the decryption processor is connected to both the private and public networks and determines access to the said each customer's financial account on the basis of the decrypted information. For the above deficiencies, we find that the examiner has not met the initial showings for a *prima facie* case of obviousness and we cannot sustain the rejection of independent claims 1 and 17 and their dependent claims 2-4, 9-12, 18-23, and 25. Additionally, the examiner has not identified how Bocinsky, Jr. and Campbell remedy the noted deficiencies. Therefore, we cannot sustain the rejection of dependent claims 5-8, 13-16 and 24.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-25 under 35 U.S.C. § 103(a) is REVERSED.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge

LEE E. BARRETT
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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